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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 10/674,167  | 09/29/2003  | James A. Yonge       | 18537.83745-001 1953    |                  |
| 7590 10/20/2004   |             | EXAMINER             |                         |                  |
| Warner Norcross & Judd LLP  |             |                      | CRAWFORD, GENE O        |                  |
| Intellectual Property Practice Group 900 Fifth Third Center 111 Lyon Street, N.W. Grand Rapids, MI 49503-2487 |             |                      | ART UNIT                | PAPER NUMBER     |
|   |             |                      | 3651                    |                  |
|   |             |                      | DATE MAILED: 10/20/2004 |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

| . ,  |  | Application No.  | Applicant(s)  |  |  |  |
|--|--|--|---|--|--|--|
| 4  |  | 10/674,167   | YONGE ET AL.  |  |  |  |
| 1  | Office Action Summary  | Examiner   | Art Unit  |  |  |  |
|  |  | Gene O. Crawford   | 3651  |  |  |  |
| <br>Period for   | The MAILING DATE of this communication app Reply   | ears on the cover sheet with the co  | orrespondence address   |  |  |  |
| THE M/ - Extension after SI2 - If the period of the period | RTENED STATUTORY PERIOD FOR REPLY AILING DATE OF THIS COMMUNICATION. ons of time may be available under the provisions of 37 CFR 1.13 (x (6) MONTHS from the mailing date of this communication. viriod for reply specified above is less than thirty (30) days, a reply period for reply is specified above, the maximum statutory period we to reply within the set or extended period for reply will, by statute, ly received by the Office later than three months after the mailing patent term adjustment. See 37 CFR 1.704(b).  | 36(a). In no event, however, may a reply be time within the statutory minimum of thirty (30) days will apply and will expire SIX (6) MONTHS from the cause the application to become ABANDONED | ety filed  will be considered timety. he mailing date of this communication. 0 (35 U.S.C. § 133). |  |  |  |
| Status   |  |  |   |  |  |  |
| 1)□ R  | esponsive to communication(s) filed on   | _·   |   |  |  |  |
| 2a) <u></u> ⊤  | This action is FINAL. 2b)⊠ This action is non-final.   |  |   |  |  |  |
| • • •  |  |  |   |  |  |  |
| closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.  |  |  |   |  |  |  |
| Dispositio   | n of Claims  |  |   |  |  |  |
| 4)⊠ C<br>44<br>5)□ C<br>6)⊠ C<br>7)□ C   | Claim(s) 1-19 is/are pending in the application.  a) Of the above claim(s) is/are withdravel is/are allowed.  Claim(s) 1-19 is/are rejected.  Claim(s) is/are objected to.  Claim(s) are subject to restriction and/or   | vn from consideration.   |   |  |  |  |
| Applicatio   | n Papers   |  |   |  |  |  |
| 10)□ TI<br>A<br>R  | he specification is objected to by the Examine he drawing(s) filed on is/are: a) acception acception and acception and acception and acception and acception are declarated as a specific process of the contraction and acceptance of the contraction and acceptance of the contraction acceptance of the c | epted or b) objected to by the Eddrawing(s) be held in abeyance. See ion is required if the drawing(s) is obj  | ected to. See 37 CFR 1.121(d).  |  |  |  |
| Priority un  | der 35 U.S.C. § 119  |  |   |  |  |  |
| a)□<br>1<br>2<br>3   | cknowledgment is made of a claim for foreign    All   b)   | s have been received.<br>s have been received in Application<br>rity documents have been receive<br>u (PCT Rule 17.2(a)).  | on No<br>d in this National Stage   |  |  |  |
| 2) Notice (3) Informa  | of References Cited (PTO-892) of Draftsperson's Patent Drawing Review (PTO-948) ation Disclosure Statement(s) (PTO-1449 or PTO/SB/08) No(s)/Mail Date 9/29/2003.   | 4) Interview Summary Paper No(s)/Mail Da 5) Notice of Informal Pa 6) Other:  |   |  |  |  |

#### **DETAILED ACTION**

## Claim Rejections - 35 USC § 112

- 1. The following is a quotation of the second paragraph of 35 U.S.C. 112:
  - The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
- 2. Claims 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- 3. Claim 12 recites the limitation "the security label" in line 1. There is insufficient antecedent basis for this limitation in the claim.

## Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 5. Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Crum.

The method for filling a prescription with at least a portion of the contents stored in a bulk container disclosed by Crum includes all the claimed features and in particular includes: (claims 1, 8, 16) transferring pharmaceutical contents from a bulk container to a consumer container, the bulk container containing a security label including a primary label 80 adhered to the bulk container 94, a piggyback label 22 having identification features removably secured to the primary label; removing the piggyback

container (column 4, lines 64, 65).

Art Unit: 3651

label from the bulk container and applying the label to a consumer container thus ensuring authenticity (column 4, lines 2-8); (claims 2, 3) reviewing a prescription, the prescription prescribing a number of units of pharmaceutical products and transferring the products from a bulk container to a consumer container (column 4, lines 2-8); (claims 4-6, 12-14, 18, 19) the primary label including an expanded content device 34 including a page 36 to which the piggyback label 22 is removably attached and wherein the page 36 is folded out from the expanded content device; (claims 7, 15, 17) the security label includes indicia identifying the contents; and (claim 11) the primary label including instructions for removing the piggyback label and transferring it to the second

With regard to claims 9 and 10, the method including quantitatively measuring the pharmaceutical products before the contents transferring step is a step that is inherent in most if not all pharmacy settings and while Crum does not affirmatively disclose this step it is inherent in view that Crum discloses its method is used in a pharmacy setting.

### Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following is cited to show the art with respect to piggyback labels for labeling containers: Shanley.

Application/Control Number: 10/674,167

Art Unit: 3651

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gene O. Crawford whose telephone number is 703/305-9733. The examiner can normally be reached on Monday thru Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Ellis can be reached on 703/308-1113. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Primary Examiner

Page 4

Art Unit 3651

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